

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit : 3635
Applicants : Philip C. Georgeau et al.
Appln. No. : 10/726,341
Filing Date : December 3, 2003
Confirmation No. : 9027
For : ROOFING SYSTEM AND METHOD

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

REPLY UNDER 37 C.F.R. §1.116

In the Office Action dated Sept 6, 2007, claim 16 was rejected under 35 USC §103 over Venable U.S. Patent No. 4,996,812 in view of Georgeau et al. U.S. Patent No. 6,579,924, and in view of Van Wagoner U.S. Patent No. 4,719,723 and further in view of Beck U.S. Patent No. 4,498,267. The Office Action states that "applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, this action is made final. See MPEP §706.07(a)."

The preceding Office Action (dated Feb. 23, 2007), states that "claim 16 is allowable over the prior art of record."

MPEP §706.07(a) states that "under present practice, second or any subsequent actions on the merits shall be final, except where the Examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an Information Disclosure Statement filed during the period set forth in 37 CFR §1.97(c) with the fees set forth in 37 CFR §1.17(p)."

Claim 16 was not amended in the response dated June 25, 2007, such that the new grounds of rejection of claim 16 could not have been necessitated by applicant's amendment.

Accordingly, the present Office Action clearly cannot be made final according to the criteria set forth in MPEP §706.07(a).

Applicants : Philip C. Georgeau et al.
Appln. No. : 10/726,341
Page 2

Also, the Office Action dated Sept. 6, 2007, states that claims 1-27 are rejected under 35 USC §112, first paragraph, "as failing to comply with the written description requirement. . . the independent claim [sic] recites a membrane with a lower or first side free of fleece. This text is not in the specification or the originally filed disclosure."

As noted in the response dated June 25, 2007, non-fleece membranes are disclosed at paragraph 16 of the present application as filed. Specifically, paragraph 16 of the present application, as filed, states that "although fleece-backed waterproof membrane material is one aspect of the present invention, the invention is not limited to the use of such material and alternative waterproof membranes can be used without a fleece bonding surface. Such alternative membranes can be composed of ethylene propylene dimer (EPDM), polyvinyl chloride (PVC), polyisobutylene (PIB) and certain thermoplastic polyolefin (TPO) membranes. The invention further includes any waterproof membrane to which the described polyether moisture cure adhesive provides sufficient adhesion to form a permanent bond." (emphasis added) Thus, the basis for the rejection under §112, first paragraph, is somewhat unclear.

According to MPEP §2163, there is no *in haec verba* requirement, and "the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed." Citing *Vas-Cath, Inc.*, 935 Fed. 2d at 1563-64, 19 USPQ2d at 1117. Furthermore, MPEP §2163 states that "The Examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims."

The present application, as filed, sets forth in plain English that the invention is not limited to a waterproof membrane having a layer of fleece material, and one skilled in the art would readily recognize that the written description of the invention provides support for the

Applicants : Philip C. Georgeau et al.

Appln. No. : 10/726,341


Page 3

claims. Furthermore, independent claims 16, 17, and 21, do not recite a membrane that is free of fleece, such that the rejection of these claims on the basis that "the independent claim [sic] recites a membrane with a lower or first side free of fleece" is clearly improper, and should be withdrawn. Similarly, dependent claims 18-20 and 22-27 also do not recite "a membrane with a lower or first side free of fleece," such that rejection of these claims on this basis is also clearly improper, and should be withdrawn.

Applicants have made a concerted effort to place the present application in condition for allowance, and a notice to this effect is earnestly solicited. In the event there are any remaining informalities, the courtesy of a telephone call to the undersigned attorney would be appreciated.

Respectfully submitted,

11/7/07
Date


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